UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/269,598	06/22/2007	Peter E. Lipsky	UTSD:1219US 10022982	1305

32425 7590 10/26/2011

FULBRIGHT & JAWORSKI L.L.P.
98 SAN JACINTO BOULEVARD
SUITE 1100
AUSTIN, TX 78701-4255

EXAMINER	
MCCORMICK, MELENIE LEE	

ART UNIT	PAPER NUMBER
1655	

NOTIFICATION DATE	DELIVERY MODE
10/26/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

aopatent@fulbright.com

Office Action Summary	Application No.	Applicant(s)	
	09/269,598	LIPSKY ET AL.	
	Examiner	Art Unit	
	MELENIE MCCORMICK	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 August 2011*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *1,4,5 and 7* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *1,4,5 and 7* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's remarks with claim amendments submitted 08/17/2011 have been received and considered.

Claims 1, 4-5 and 7 are pending and presented for examination on the merits.

Withdrawn Rejections

The previous Obviousness-type double patenting rejections have been withdrawn in light of the amendments to the claims, which now require the administration of a steroid and which also require that the extract administered is an ethanol extract.

The previous prior art rejections have been withdrawn in light of the amendments to the claims, which now require the administration of a steroid and which also require that the extract administered is an ethanol extract.

New Rejections

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-5 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,294,443

in view Wiedmann et al. (WO 9513082) in view of Murray (1994) with evidence provided by wikipedia.org.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '443 are drawn to a method for suppressing interleukin-2 in autoimmune disease comprising administering a preparation consisting essentially of a *Tripterygium wilfordii* Hook F root extract in a therapeutically effective amount to a patient having an autoimmune disease sufficient to suppress interleukin-2 production (see e.g. claim 2). The claims of '443 further teach that the autoimmune disease may be rheumatoid arthritis (see e.g. claim 3). The claims of '443 further teach that the therapeutically effective amount is 60 mg/day (see e.g. claim 8). The steroid sparing effect recited in the instant claims would necessarily occur because the same amount of the same composition (i.e. 60 mg per day of an extract of *Tripterygium wilfordii* Hook F root) was administered to the same patient population as instantly claimed. Therefore, the ability to administer less prednisone to a patient due to the method disclosed by the claims of '443 would necessarily be present.

The claims of '443 do not explicitly teach that the extract administered in an ethanol extract, that the extract contains triptolide or that prednisone is also administered.

Wiedmann et al. teach an ethanol extract of *Tripterygium wilfordii* Hook F root which has immunosuppressive activity (see e.g. page 4, lines 20-31 and page 7, lines 10-30). Wiedmann et al. further teach that the extract is useful for treating a number of autoimmune diseases, including rheumatoid arthritis (see e.g. page 14-15).

Murray teaches that corticosteroids are used to treat a wide range of inflammatory and allergic conditions, including rheumatoid arthritis (see page 51). Murray further teaches that prednisone is by far the most often prescribed oral corticosteroid (see page 52). Murray further teaches that although prednisone is of great benefit in treating chronic inflammatory conditions, it is associated with a number of side effects (see page 52). Murray et al. teach that the side effects of oral corticosteroids are a function of dosage levels and length of time on the medication (see page 52).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use an ethanol extract in the method disclosed by the claims of '443. A person of ordinary skill in the art would have had a reasonable expectation of success in doing so based upon the disclosure of Wiedmann et al. that an ethanol extract of *Tripterygium wilfordii* Hook F root has immunosuppressive activity and is useful for rheumatoid arthritis, systemic lupus erythematosus. Therefore, a person of ordinary skill in the art would have been motivated to administer an effective amount of an ethanol extract of *Tripterygium wilfordii* Hook F root to a subject for treating the immune disease rheumatoid arthritis since Wiedmann et al. teaches that such an extract is immunosuppressive and is useful for treating this disease. Since the extract is an ethanol extract, as instantly claimed, it would necessarily have anti-inflammatory and immunosuppressive pharmacological activity, contain triptolide, and provide for a steroid-sparing effect, as instantly claimed. As evidenced by wikipedia.org, rheumatoid arthritis is a chronic systemic inflammatory disorder. Therefore, administration of the same extract as claimed to patients suffering from such an

inflammatory condition would treat inflammation, as instantly claimed. It would have further been obvious to one of ordinary skill in the art to also administer prednisone to the patients with rheumatoid arthritis because, as disclosed by Murray, corticosteroids are used to treat inflammatory conditions, including rheumatoid arthritis. Since prednisone is the most commonly prescribed corticosteroid for treating inflammatory conditions, a person of ordinary skill in the art would have good reason to use prednisone as the particular corticosteroid. Since Murray et al. disclose the danger of side effects from the use of corticosteroids and teach that the side effects are a function of the dosage levels, a person of ordinary skill in the art would have good reason to use a low dosage of the steroid. Since administration of an extract along with the steroid is obvious in light of the claims of '443 and the cited references, since a person of ordinary skill in the art would understand that the extract treats RA and since corticosteroids are known to cause side effects, a person of ordinary skill in the art would reasonably be expected to administer the lowest dosage possible of the steroid, in combination with the extract. Optimization of this amount would be reasonably expected in order to achieve the least amount of side effects and the greatest efficacy and therefore a person of ordinary skill in the art would have a reasonable expectation of success in administering a pharmacologically effective amount of the extract as instantly claimed and an amount of a steroid which would be less than an amount capable of providing pharmacological activity in the absence of the extract.

Claims 1, 4-5 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 11 of U.S. Patent No. 5,580,562 in view of Wiedmann et al. (WO 9513082) Murray (1994) with evidence provided by wikipedia.org

The claims of '562 are drawn to an ethanol extract of the woody plant of *Tripterygium wilfordii* Hook F having a triptolide concentration of about 0.3 to 1.3 micrograms/milligram (see e.g. claim 8).

Wiedmann et al. teach an ethanol extract of *Tripterygium wilfordii* Hook F root which has immunosuppressive activity (see e.g. page 4, lines 20-31 and page 7, lines 10-30). Wiedmann et al. further teach that the extract is useful for treating a number of autoimmune diseases, including rheumatoid arthritis (see e.g. page 14-15).

Murray teaches that corticosteroids are used to treat a wide range of inflammatory and allergic conditions, including rheumatoid arthritis (see page 51). Murray further teaches that prednisone is by far the most often prescribed oral corticosteroid (see page 52). Murray further teaches that although prednisone is of great benefit in treating chronic inflammatory conditions, it is associated with a number of side effects (see page 52). Murray et al. teach that the side effects of oral corticosteroids are a function of dosage levels and length of time on the medication (see page 52).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use an ethanol extract in the method disclosed by the

claims of '562. A person of ordinary skill in the art would have had a reasonable expectation of success in doing so based upon the disclosure of Wiedmann et al. that an ethanol extract of *Tripterygium wilfordii* Hook F root has immunosuppressive activity and is useful for treating rheumatoid arthritis. Therefore, a person of ordinary skill in the art would have been motivated to administer an effective amount of an ethanol extract of *Tripterygium wilfordii* Hook F root to a subject for treating the immune disease rheumatoid arthritis since Wiedmann et al. teaches that such an extract is immunosuppressive and is useful for treating this disease. Since the extract is an ethanol extract, as instantly claimed, it would necessarily have anti-inflammatory and immunosuppressive pharmacological activity, contain triptolide, and provide for a steroid-sparing effect, as instantly claimed. It would have further been obvious to one of ordinary skill in the art to also administer prednisone to the patients with rheumatoid arthritis because, as disclosed by Murray, corticosteroids are used to treat inflammatory conditions, including rheumatoid arthritis. Since prednisone is the most commonly prescribed corticosteroid for treating inflammatory conditions, a person of ordinary skill in the art would have good reason to use prednisone as the particular corticosteroid. Since Murray et al. disclose the danger of side effects from the use of corticosteroids and teach that the side effects are a function of the dosage levels, a person of ordinary skill in the art would have good reason to use a low dosage of the steroid. Since administration of an extract along with the steroid is obvious in light of the claims of '443 and the cited references, since a person of ordinary skill in the art would understand that the extract treats RA and since corticosteroids are known to cause side effects, a

person of ordinary skill in the art would reasonably be expected to administer the lowest dosage possible of the steroid, in combination with the extract. Optimization of this amount would be reasonably expected in order to achieve the least amount of side effects and the greatest efficacy and therefore a person of ordinary skill in the art would have a reasonable expectation of success in administering a pharmacologically effective amount of the extract as instantly claimed and an amount of a steroid which would be less than an amount capable of providing pharmacological activity in the absence of the extract.

Claims 1, 4-5 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,916,564 in view of Wiedmann et al. (WO 9513082) in view of Murray (1994) with evidence provided by wikipedia.org.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '564 are drawn to a method of immunosuppression and suppressing an autoimmune disease comprising administering *Tripterygium wilfordii* Hook F root extract in a therapeutically effective amount to a patient in need of such treatment, said amount inhibiting interleukin-2 production without substantial cellular toxicity (see e.g. claims 1 and 3). The claims of '564 also teach that

the preparation comprises tripdiolide or triptolide (see e.g. claim 2). The claims of '564 are also drawn to the method of immunosuppression wherein the subject has an autoimmune disease which may be rheumatoid arthritis, (see e.g. claim 4). The claims of '564 teach that the therapeutically effective amount is about 60 mg/kg/day (see e.g. claim 8). The claims of '564 are also drawn to a method of treating inflammation or immune disease in a subject comprising administering to the subject a pharmacologically active amount of a *Tripterigium wilfordii* F root extract, the preparation having anti-inflammatory and immunosuppressive pharmacological activity, and a steroid, wherein the method provides a steroid sparing effect, wherein the steroid is prednisone (see e.g. claims 11 and 17). The claims of '564 are further drawn to the method wherein the immune disease is an autoimmune disease, including rheumatoid arthritis (see e.g. claim 13). The claims of '564 are further drawn to the method wherein the extract is an ethanol extract of *Tripterigium wilfordii* (see e.g. claim 18).

The claims of '564 do not explicitly teach that teach that the extract administered is an ethanol extract or that prednisone is also administered.

Wiedmann et al. teach an ethanol extract of *Tripterygium wilfordii* Hook F root which has immunosuppressive activity (see e.g. page 4, lines 20-31 and page 7, lines 10-30). Wiedmann et al. further teach that the extract is useful for treating a number of autoimmune diseases, including rheumatoid arthritis (see e.g. page 14-15).

Murray teaches that corticosteroids are used to treat a wide range of inflammatory and allergic conditions, including rheumatoid arthritis (see page 51). Murray further teaches that prednisone is by far the most often prescribed oral

corticosteroid (see page 52). Murray further teaches that although prednisone is of great benefit in treating chronic inflammatory conditions, it is associated with a number of side effects (see page 52). Murray et al. teach that the side effects of oral corticosteroids are a function of dosage levels and length of time on the medication (see page 52).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use an ethanol extract in the method disclosed by the claims of '564. A person of ordinary skill in the art would have had a reasonable expectation of success in doing so based upon the disclosure of Wiedmann et al. that an ethanol extract of *Tripterygium wilfordii* Hook F root has immunosuppressive activity and is useful for treating rheumatoid arthritis. Therefore, a person of ordinary skill in the art would have been motivated to administer an effective amount of an ethanol extract of *Tripterygium wilfordii* Hook F root to a subject for treating the immune disease rheumatoid arthritis since Wiedmann et al. teaches that such an extract is immunosuppressive and is useful for treating this disease. Since the extract is an ethanol extract, as instantly claimed, it would necessarily have anti-inflammatory and immunosuppressive pharmacological activity, contain triptolide, and provide for a steroid-sparing effect, as instantly claimed.

It would have further been obvious to one of ordinary skill in the art to also administer prednisone to the patients with rheumatoid arthritis (RA) because, as disclosed by Murray, corticosteroids are used to treat inflammatory conditions, including rheumatoid arthritis. Since prednisone is the most commonly prescribed corticosteroid for treating inflammatory conditions, a person of ordinary skill in the art would have good

reason use prescribe prednisone as the particular corticosteroid. Since Murray et al. disclose the danger of side effects from the use of corticosteroids and teach that the side effects are a function of the dosage levels, a person of ordinary skill in the art would have good reason to use a low dosage of the steroid. Since administration of an extract along with the steroid is obvious in light of the claims of '564 and the cited references, since a person of ordinary skill in the art would understand that the extract treats RA and since corticosteroids are known to cause side effects, a person of ordinary skill in the art would reasonably be expected to administer the lowest dosage possible of the steroid, in combination with the extract. Optimization of this amount would be reasonably expected in order to achieve the least amount of side effects and the greatest efficacy and therefore a person of ordinary skill in the art would have a reasonable expectation of success in administering a pharmacologically effective amount of the extract as instantly claimed and an amount of a steroid which would be less than an amount capable of providing pharmacological activity in the absence of the extract.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipsky et al. (US 5,294,443) in view of Murray (1994) in view of Wright (1963) with evidence provided by wikipedia.org.

Lipsky et al. teach a method for inhibiting interleukin-2 in autoimmune disease comprising administering a preparation consisting essentially of a *Tripterygium wilfordii* Hook F root extract in a therapeutically effective amount to a patient having an autoimmune disease sufficient to suppress interleukin-2 production (see e.g. claim 2). Lipsky et al. further teach that the autoimmune disease is rheumatoid arthritis (see e.g. claim 3). Lipsky et al. further teach that the therapeutically effective amount is 60 mg/day (see e.g. claim 8). Lipsky et al. further teach a particular embodiment wherein rheumatoid arthritis patients (i.e. patients with an autoimmune disease) are treated with 60 mg per day of an extract of *Tripterygium wilfordii* Hook F root, which is a mixture of compounds extracted from T *Tripterygium wilfordii* Hook F and is referred to as "T2" (see e.g. col 11, Example 3). Lipsky et al. teach that T2 is a chloroform ethanol extract of the woody potion of *Tripterygium wilfordii* Hook F root (see e.g. page col 1, lines 40-42) and that the extract contains components including triptolide and wilforonide (see e.g. col 2, lines 48-52). In addition, Lipsky et al. teach that rheumatoid arthritis patients treated with T2 showed improvement in different clinical criteria or laboratory correlates of inflammation and that an immunosuppressive activity was implicated by the finding that the treatment induced inhibition of the production of IgM and IgM rheumatoid factor by the patient's peripheral blood mononuclear cells in vitro (see e.g. col 1, lines 49-62 and col 15, lines 52-62). Therefore, Lipsky et al. teach a method for treating

inflammation and an immune disease in a subject comprising administering to the subject a pharamcalogically effective amount of a *Tripterygium wilfordii* Hook F root preparation, the preparation having anti-inflammatory and immunosuppressive activity, as instantly claimed. Lipsky et al. further teach that a steroid sparing effect was noted (see e.g. col 15, lines 65-66).

Lipsky et al. do not explicitly teach that an ethanol extract of *Tripterygium wilfordii* Hook F root is administered or that a corticosteroid is also administered.

Wiedmann et al. teach an ethanol extract of *Tripterygium wilfordii* Hook F root which has immunosuppressive activity (see e.g. page 4, lines 20-31 and page 7, lines 10-30). Wiedmann et al. further teach that the extract is useful for treating a number of autoimmune diseases, including rheumatoid arthritis (see e.g. page 14-15).

Murray teaches that corticosteroids are used to treat a wide range of inflammatory and allergic conditions, including rheumatoid arthritis (see page 51). Murray further teaches that prednisone is by far the most often prescribed oral corticosteroid (see page 52). Murray further teaches that although prednisone is of great benefit in treating chronic inflammatory conditions, it is associated with a number of side effects (see page 52). Murray et al. teach that the side effects of oral corticosteroids are a function of dosage levels and length of time on the medication (see page 52).

Wright et al. teach that the dangers of corticosteroid therapy in patients with rheumatoid arthritis make valuable any regime which would enable the effective dosage to be reduced (see e.g. page 348, first para). Wright et al. further teach that any method

permitting reduction of steroid dosage in patients with rheumatoid arthritis is worthy of investigation (see page 351, Discussion).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made use an ethanol extract of *Tripterygium wilfordii* Hook F root in the method of treating rheumatoid arthritis (RA) disclosed by Lipsky et al. A person of ordinary skill in the art would have had a reasonable expectation of success in doing so based upon the disclosure of Wiedmann et al. that an ethanol extract of *Tripterygium wilfordii* Hook F root has immunosuppressive activity and is useful for treating rheumatoid arthritis. Therefore, a person of ordinary skill in the art would have been motivated to administer an effective amount of an ethanol extract of *Tripterygium wilfordii* Hook F root to a subject for treating the immune disease rheumatoid arthritis, since Wiedmann et al. teaches that such an extract is immunosuppressive and is useful for treating these diseases. A person of ordinary skill in the art would be motivated to administer about 60 mg/day of the ethanol extract since Lipsky et al teach that this amount chloroform ethanol extract was useful for treating RA. Since the extract is an ethanol extract, as instantly claimed, it would necessarily have anti-inflammatory and immunosuppressive pharmacological, contain triptolide, and provide for a steroid-sparing effect, as instantly claimed.

It would have further been obvious to one of ordinary skill in the art to also administer prednisone to the patients with rheumatoid arthritis in the method rendered obvious by Lipsky et al. and Weidmann et al. A person of ordinary skill in the art would have had a reasonable expectation of success in doing so since, as disclosed by

Murray, corticosteroids are used to treat inflammatory conditions, including rheumatoid arthritis. Since prednisone is the most commonly prescribed corticosteroid for treating inflammatory conditions, a person of ordinary skill in the art would have good reason administer prednisone as the particular corticosteroid. Since Murray et al. disclose the danger of side effects from the use of corticosteroids and teach that the side effects are a function of the dosage levels, a person of ordinary skill in the art would have good reason to use a low dosage of the steroid. In addition, since Lipsky et al. disclose that the chloroform ethanol extract had a steroid sparing effect and since the ethanol extract disclosed by Weidmann et al. is immunosuppressive and useful for treating RA just as the chloroform ethanol extract disclosed by Lipsky et al. is immunosuppressive and useful for treating RA, a person of ordinary skill in the art would have good reason to administer a very low dosage of the ethanol extract in order to minimize side effects and investigate a possible steroid sparing effect of the ethanol extract. This is especially true in light of the disclosure of Wright et al. that the dangers of corticosteroid therapy in RA make valuable any regime which would enable the effective dosage to be reduced and that any method permitting reduction of steroid dosage (i.e. a steroid sparing effect) in patients with rheumatoid arthritis is worthy of investigation. Therefore, a person of ordinary skill in the art would have good reason to adjust the amount of the steroid administered in combination with the *Tripterygium wilfordii* Hook F root ethanol extract in the method rendered obvious by the instantly cited references in order to provide the lowest amount of the steroid which would be necessary for treating RA in combination with the extract. Thus, a person of ordinary skill in the art would be reasonably

expected, through optimization of the amount of the steroid, to administer an amount of the steroid in combination with the extract which would be an amount less than capable of providing pharmacological activity in the absence of the *Tripterygium wilfordii* Hook F root extract.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Response to Arguments

Applicants argue that all of the previous rejections have been overcome since the claims now recite that the *Tripterygium wilfordii* Hook F root preparation is an ethanol extract and since the claims also now require co-administration of a steroid. While the previous rejections have been overcome by these amendments, as discussed above, the amended claims are rejected for the reasons set for in the new rejections above, which were necessitated by Applicants' amendments to the claims.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELENIE MCCORMICK whose telephone number is (571)272-8037. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melenie McCormick/
Primary Examiner, Art Unit 1655